

REMARKS/ARGUMENTS

Status

Claim 17 has been cancelled by the present amendment and no claim has been added. Claims 3-16 and 18-20 will remain for further consideration.

Claim History

The Examiner rejected claims 3-8, 19 and 9-15, 20 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner rejected claims 3-8, 19 and 9-10, 14, 15, 20, 16-18 under 35 U.S.C. § 103 over Costin, IV in view of Kaplan and Swimathon or Fidler. The Examiner rejected claims 3-8, 19 and 9-15, 20, 16-18 under 35 U.S.C. § 103 over Costin, IV in view of Kaplan, Fidler and Swimathon.

Claim Objections

Claim 4 properly limits the scope of claim 3. Claim 3 is directed to a “method of raising capital” that includes an on-line website. This is distinct from the Examiner’s statement that the invention is an “on-line website.” The claims are method claims and not device claims, and the on-line website is just one limitation of the claim. Paragraph (c) (as delineated by the Examiner) of claim 3 recites “broadcasting said bounty offering to a plurality of viewers.” This broadcast is not necessarily on-line or off-line. Therefore, the limitation provided in claim 4 of “broadcasting said bounty offering on television” limits the claim, because the broadcast must be in a format that is receivable by televisions, whether this is UDP, over the air, cable, satellite or some other form. An on-line website could broadcast to a television using UDP format or other formats known to those of ordinary skill in the art. This broadcast could also be in addition to an “on-line” broadcast of

paragraph (b) and/or (c). However, because the limitation is of a different scope than that of claim 3, the limitation is proper. The connection to the method of raising capital is that viewers of the television will view the broadcast, and as is stated in paragraph (c) of claim 3 "said viewers watching the broadcast contribute money towards the reward to be paid by the benefactor." For at least these reasons, claim 4 properly limits claim 3, which is to a "method of raising capital." There is no requirement that a dependent claim necessarily limit each and every recitation of the independent claim, such as the on-line site of paragraph (a) of claim 3. "One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application." MPEP § 608.01(n). Only the claim must be limited by the dependent claim, not any specific recitation of the claim. The Applicant therefore requests that the Examiner withdraw this objection.

Claims 10-12 likewise are in proper dependent form. Since the independent claim recites "a" bounty offering, claim 10 has a recitation to "a plurality of bounty offerings simultaneously." The independent claim does not require these "plurality" of bounty offerings as part of the "method of raising capital" and therefore the scope of claims 9 and 10 are different. Therefore, claim 10 is of proper dependent form. Claim 10 is to a method of raising capital having a plurality of bounty offerings, which is clearly of a different scope than the base claim requiring only "a" bounty offering. Likewise, claims 11 and 12 require a second benefactor. Claim 11 further recites a competition between the bounty offerings and claim 12 recites only payment to a completed bounty offering condition. These limit the invention, namely "a method of raising capital" and are not required to further limit each and every limitation recited in a dependent claim, namely the on-line site of paragraph (a).

35 U.S.C. § 112

The Examiner rejected claims 3-8, 19 and 9-15, 20 under 35 U.S.C. § 112, [second paragraph, as being indefinite. The Examiner stated in the rejection that there is no discussion in the body of the claim of how the capital is raised and for who. The Applicant respectfully disagrees. Claim 3 specifically recites that the bounty offering is broadcast, viewers watch the broadcast and contribute money towards the reward. The money is then paid upon completion of the condition to the beneficiary. In this way, money is raised and distributed.

As to the recitation “for registering,” it is quite clear that the web site is used so that the parties register the bounty offering *with the website*. The recitation clearly recites “establishing an on-line site for registering a bounty offering” and “establishing an on-line site for broadcasting a bounty offering” in the single phrase. This is the distributive property of the English language and is clear on its face. (Note also the Examiner’s use of the same phrase at the top of page 7 of the Office Action, when explaining the alleged disclosure of Costin, IV.) “If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” *MPEP § 2173.05 (e)*; see also *Ex parte Porter*, 25 USPQ 2d 1144, 1145 (Bd. Pat. App. & Inter. 1992). Any person may register a bounty offering with the website, and therefore there is no reason to distinguish who is registering the site. One skilled in the art would appreciate the scope of this phrase.

The term “actor” is explained within the specification. It is not limited to an actor in the sense of one who acts as a profession, but rather a person who performs certain conditions required in the bounty offering. See for instance “The triggering event can also be a non-monetary event such as a celebrity or other individual or entity (“actor”)

performing a certain pre-designated entertainment-related activity, such as a screen-star agreeing to a blind date with the winner of a competition.” (Specification ¶009) Also, see ¶024(B) which defines actor as “party or parties meeting the conditions or attempting to meet the conditions of the Bounty.” The Applicant is allowed to be his own lexicographer, and defining the “actor” as the “acting” party (i.e., who completes or attempts to complete a condition) is certainly consistent with the general meaning of the word.

Claims 3 and 9 have been amended to use the term “beneficiary” in both paragraphs (a) and (d). This should obviate this grounds for rejection.

Claim 8 has been amended to depend from claim 3. This should obviate this grounds for rejection.

Claim 13 has been amended to depend from claim 10. This should obviate this grounds for rejection.

35 U.S.C. § 103

The Examiner rejected claims 3-8, 19 and 9-10, 14, 15, 20, 16-18 under 35 U.S.C. § 103 over Costin, IV in view of Kaplan and Swimathon or Fidler. The Examiner rejected claims 3-8, 19 and 9-15, 20, 16-18 under 35 U.S.C. § 103 over Costin, IV in view of Kaplan, Fidler and Swimathon. This rejection is respectfully traversed.

The combination of the references used to reject the current application is impermissible and cannot stand.

The invention must be considered as a whole without the benefit of hindsight, and the claims must be considered in their entirety. Rockwell International Corp. v. United States, 147 3 F.3d 1358, 1364 (Fed. Cir. 1998).

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). It is impermissible to use the claimed invention as a blueprint from which to reconstruct the prior art to satisfy the claimed invention. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543, 548 (Fed. Cir. 1985) ("From its discussion of the prior art it appears to us that the court, guided by the defendants, treated each reference as teaching *one* or more of the specific components for use in the Feil system, although the Feil system did not then exist. Thus the court reconstructed the Feil system, using the blueprint of the Feil claims. As is well established, this is legal error.")

The prior art must be considered as a whole and suggest the desirability and thus the obviousness of making the combination. Lindermann Maschinentabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)

There must be a suggestion or motivation in the prior art to modify a reference to satisfy the claimed invention. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."
Id. (emphasis added)

"When an obviousness determination is based *on* multiple references, there must be a showing of some 'teaching, suggestion, or reason' to combine the

references...Although a reference need not expressly teach that the disclosure contained therein should be combined with another the showing of combinability, in whatever form, must be '*clear and particular.*'" Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1348-1349 (Fed. Cir.), cert. denied, 530 U.S. 1238 (2000)(emphasis added)

"The factual inquiry whether to combine references must be thorough and searching'...*It must be based on objective evidence of record.* This precedent has been reinforced in myriad decisions and cannot be dispensed with...The need for specificity pervades this authority...This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority...'Common knowledge and common sense,' even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority." In re Lee, 277 F.3d 1338, 1343-1345 (Fed. Cir. 2002)

"There is no suggestion to combine, however, if a reference teaches away from its combination with another source." Tech Air, Inc., 192 F.3d at 1360 (emphasis added). See also Winner International Royalty Corp., 202 F.3d at 1349-1350 ("Second, if Johnson did in fact teach away from Moore, then that finding alone can defeat Wang's obviousness claim.")

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path taken by the applicant... [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by applicant." In re Gurley, 27 F. 3d 551,

553, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994) and Tech Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999).

There is no reason to combine Kaplan and Costin. Kaplan is to a method of providing a competition between potential parties to have a problem solved. There is no teaching of using the system as a means of raising capital, but conversely, as a means of solving a problem. In Kaplan, money is used to solve a problem. The problem is not used to raise money, though Kaplan does say that users are "encouraged" to donate money to charity. Additionally, in Kaplan, the actor (i.e., the person completing the condition) is the benefactor, unlike the present invention. Costlin cannot be combined with Kaplan. There is no reason to combine them, as Kaplan is not a capital raising website, but merely a means for allowing people to compete for money which is already offered. Costin merely provides a method of sending out e-mails with links where a donor can donate money directly to a charity. There is no benefactor, no actor, no conditions, etc. There is no reason to combine, and even if the references were combined, the combination does not cure the deficiencies of either and does not provide an actor completing a condition so that a benefactor will release funds to a recipient other than the actor. Fidler and BT Swimathon merely show a game show and a swimathon where money is donated to a charity. Neither of these shows an on-line website for registering a bounty offering providing a beneficiary and viewers that contribute to a beneficiary when an actor (not the beneficiary) complete a condition. For at least these reasons, the claims of record should be allowed.

Summary

Applicants have made a diligent and bona fide effort to answer each and every ground for rejection or objection to the specification including the claims and to place the application in condition for final disposition. Reconsideration and further examination is respectfully requested, and for the foregoing reasons, Applicant respectfully submits that this application is in condition to be passed to issue and such action is earnestly solicited. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Robert N. Blackmon, Applicants' Attorney at 703-684-5633 to satisfactorily conclude the prosecution of this application.

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Respectfully submitted,



Robert N. Blackmon
Reg. No. 39494
Attorney/Agent for Applicant(s)

Merek, Blackmon & Voorhees, LLC
673 S. Washington St.
Alexandria, Virginia 22314
Tel. 703-684-5633
Fax. 703-684-5637
E-mail: RNB@MBV-IP.com